

AF
JFW

10368/24701

Serial No.: 09/945,006



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND PATENT INTERFERENCES

In re U.S. application of: J. Pat Evans et al
U.S. Serial No.: 09/945,006
Filed: August 31, 2001
Group Art Unit: 3728
Examiner: Anthony D. Stashick
For: ORTHOPEDIC FOOTWEAR AND INSOLE THEREOF

Commissioner for
Patents
PO Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

REPLY BRIEF ON APPEAL

**CERTIFICATE OF MAILING
(37 CFR 1.8a)**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail and in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450

Date: July 3, 2006

William R Gustavson

(Typed name of person mailing paper)

(Signature of person mailing paper)

This reply brief is filed in furtherance of the Appeal filed in this application on December 9, 2005 and in reply to the Examiner's Answer mailed on May 4, 2006.

A. The Examiner's argument to sustain the Rejection of Claims 1-6, 8-11, 13-15 and 17 under 35 U.S.C. Section 102 over Schroer, Jr. et al is Respectfully Challenged

It is fundamental that Schroer, Jr. et al does not disclose a raised arch support portion having the peripheral contour related to specific anatomical foot bones as claimed in claims 1-6, 8-11, 13-15 and 17. For example, nowhere in Schroer, Jr. et al does it recite a peripheral contour which passes through a point generally in contact with a midway point between a second metatarsal head and a third metatarsal head, as does claim 2. Nor, for example, does Schroer, Jr. et al recite a peripheral contour extending across a point generally corresponding to a cuboid of the foot, as does claim 3. The Examiner clearly seems to asserts that such relationships are simply inherent in the Schroer, Jr. et al patent. However, the Examiner has not provided a sufficient rationale, nor evidence, to support such inherency.

The law is quite clear that the mere fact that a certain thing may result from a given set of circumstances is not sufficient to support anticipation. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951(Fed. Cir. 1999). Inherency may not be established by probabilities or possibilities. In re Oelrich, 212 USPQ 323, 326 (CCPA 1981). But here, the Examiner is trying to do just that. His argument is simply that the disclosure of Schroer, Jr. et al looks something like the claimed invention and therefore it must anticipate. This fails the test of inherency and proves the fallacy of the anticipation rejection.

The Examiner attaches a three page internet description of the bone structure of the foot, a document not previously of record in the prosecution history, to his Answer. However, this description does not show that the present claimed invention is inherent in Schroer, Jr. et al. The description just shows the well know bone structure of the human foot. Any extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In re Roberston, Id. at 745. This is well established law. The Board of Patent Appeals stated "the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied prior art". Ex parte Levy, 17 U.S.P.Q. 2d. 1461,1464 (Bd. Pat. App. & Int'f 1990). To put it simply, with no specific disclosure in Schroer, Jr. et al, an infinite number of guesses can be made as to the position of the Schroer, Jr. et al device relative to a foot bone structure. This fails to meet the requirement to show the necessary inherency and drives the conclusion it can't be a proper reference under Section 102 against the present claims.

The Examiner frequently asked us to compare Figures 1 and 3 of Schroer, Jr. et al. However, Figure 1 "depicts the directional terminology associated with the use of a right innersole from a top front perspective" at Column 4, lines 66-68 of Schroer, Jr. et al. Figure 1 was clearly not meant to be at all illustrative of the physical dimensions of the innersole 2 of Schroer, Jr. et al. This is particularly highlighted by comparing Figures 1, 1A, 1B and 3 of

Schroer, Jr. et al which all purport to show the same innersole 2. Figure 1A is a top view of the innersole (Column 5, lines 1-2), which clearly shows a configuration nothing like Figure 1. It is more logical to conclude Figure 3 is a side view of the configuration of Figure 1A, which clearly has no similarity whatsoever to the present claimed invention.

Even accepting the Examiner's emphasis on Figure 1 of Schroer, Jr. et al., that figure clearly does not show a peripheral contour defined by a curve extending forwardly and laterally through a point (B) generally in contact with a midway point between a second metatarsal head (M2) and a third metatarsal head (M3) as recited in claims 2 and 3. As seen in Figure 2 of the present application, this point B lies near the midline L of the upper surface of the insole, between second metatarsal head M2 and third metatarsal head M3, while Figure 1 of Schroer, Jr., et al shows no forward extension of a peripheral contour anywhere near a midline of an insole. Claims 4, 9-17 and 43 all claim a peripheral contour defined by a curve beginning at the forwardmost medial point of the longitudinal arch (point A in Figure 2 of the present application), which lies posterior to the bony protuberance of the first metatarsal point (par 23, line 7 of the present application) and extending to or proximate the second and third metatarsal heads. This curve extends generally forward as well, as the second and third metatarsal heads M2 and M3 are usually longer than the first metatarsal, as explained at paragraph 23, lines 11-12 of the present application.

It should also be emphasized that the teachings of the present invention, as embodied in the appealed claims, are not taught in the cited prior art. Thus, the Applicants of the present invention have advanced the art and made a contribution to the public good in providing the specificity of the present claims. This contribution should be acknowledged and be worthy of being patented over the Schroer, Jr. et al patent.

B. The Examiner's argument to sustain the Rejection of claims 7, 12 and 16 under 35 U.S.C. Section 103 over Schroer, Jr. et al is Respectfully Challenged

Claims 7, 12 and 16 each depend from independent claims that recite specific structural relationships between the human foot and the claimed insole. Claim 7 requires a raised arch support portion that has a maximum height dimension substantially midway between a first metatarsal head and an Astragalus of the human foot through its dependency on Claim 6. Claim 12 has a similar recitation through its dependency on claim 11. Nothing in Schroer, Jr. et al suggests such a structure. Claims 12 and 16 additionally depend from claim 9, which sets forth very specific relationships between the peripheral contour and the bones of the foot. Again, nothing in Schroer, Jr. et al suggests such a relationship.

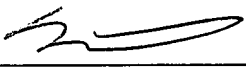
C. The Examiner's argument to sustain the Rejection of claims 42-43 and 45 under 35 U.S.C. Section 103 over Schroer, Jr. et al and Official Notice is Respectfully Challenged

The Examiner states that the parameters of the materials claiming to meet the ASTM guidelines in claims 42-43 and 45 are not inventive because they are set forth by a governing body. This is a misunderstanding of such standards. Clearly, standards organizations, such as ASTM, attempt to quantify key properties of materials by defining a given property, such as hardness, on some type of relative and reproducible scale. The standards do not teach that a given material is suitable for a given application, such as an insole, but merely defines a given property of a material. Diamonds are harder than talc, for example, which results in these materials having different hardness values, but gives no guidance to their efficacy in forming an insole as claimed in the present invention. The invention of Applicants is their efforts to determine the particular properties of a material needed to achieve the desired result. That property is then expressed by a given value in a standard, such as established by ASTM. Taken to its logical conclusion, the reasoning of the Examiner would compel one to conclude because a governing body has set forth the parameters of the elements in the Periodic table, nothing made up of any of those elements could possibly be patentable.

CONCLUSION

For the reasons set forth above, allowance of claims 1-17, 42-43 and 45 is respectfully requested.

Respectfully Submitted,
Attorneys for Applicant

By: 
William R. Gustavson
Registration No. 29,160

WRG/bg
Thompson & Gustavson, L.L.P.
June 30, 2006
Suite 1185
9330 LBJ Frwy.
Dallas, Texas 75243
(972) 479-0903